

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 3751
William T. Ball)	Confirmation No.: 2017
Serial No.: 10/732,726)	Examiner: Baker, Lori L.
Filed: December 10, 2003)	<u>PETITION FOR WITHDRAWAL</u>
Atty. File No.: 5564-152)	<u>OF A RECORDED TERMINAL</u>
)	<u>DISCLAIMER</u>
Entitled: "Method and Apparatus for Assembling)	
and Sealing Bathtub Overflow and)	<i>Electronically Submitted</i>
Waste Water Ports")	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.182, the undersigned respectfully requests that the Terminal Disclaimer filed on September 13, 2010 in connection with the above-identified patent application be withdrawn. More specifically, the Examiner formerly associated with the instant application stated in an Office Action dated April 15, 2010 that the pending claims are anticipated by the claims of the patent used as a basis for the nonstatutory obviousness-type double patenting rejection, U.S. Patent No. 6,675,406. In a Final Office Action dated October 25, 2010, however, the Examiner states that there are substantial differences between the claims of the instant application and those of U.S. Patent No. 6,675,406. The portions of the Office Action that necessitated the filing of a Terminal Disclaimer and the Examiner's more recent comments are provided herewith.

Accordingly, in view of the Examiner's change of opinion, it is requested that the Terminal Disclaimer filed to obviate the double patenting rejection be withdrawn.

Respectfully submitted,

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identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 21 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are anticipated by the patented claim, and anticipation is the epitome of obviousness.

11. Claim 23 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Gebert. Gebert teaches use of a washer 10 placed between a bathtub wall 7 and an overflow nut element 8.

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12. Claims 11-13, 15 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Ball '241. Ball '241 teaches a method of testing a plumbing system where an overflow pipe is plugged with a diaphragm 64, the system is tested, and then the overflow pipe is unplugged by cutting the diaphragm. Ball '241 further teaches (Fig. 2) that a conventional plumbing system of the type recited in the patented claim often includes a vent pipe 40 and interconnecting pipe 42.

13. Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Ball '241 and Gebert. Ball '241 and Gebert teach the subject matter missing from the patented claim, as noted above.

14. Claims 16-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Ball '241 and Ball '931. Ball '241 teaches the testing method as noted above. Ball '931 teaches a drain pipe, lock washer and drain closure associated with an overflow assembly.

15. Applicant's remarks of December 11, 2009 and April 05, 2010 have been fully considered and have been previously addressed. Concerning applicant's repeated request for an indication of

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The choice of diaphragm securement would appear an obvious choice to be made. The Delanoy et al. (Delanoy) reference teaches connecting a plumbing test diaphragm 10 to a plumbing fitting via being integrally formed with the fitting. Note page 1, lines 59-62 in Delanoy.

10. Applicant's general remarks at pages 9 and 18 of the response, that pending claims 24 and 36 are allowable because they recite similar limitations to those previously found allowable by the examiner during prosecution of Ball '406, are noted. The examiner disagrees with applicant's position for two reasons. First, the lug and cap engagement feature of the '406 patent differs significantly from the lug and cap engagement feature of the instant CIP application. Secondly, the overflow port claimed in the '406 patent includes both a sleeve feature and a hollow fitting feature. These two features are not in the disclosure of the instant CIP application. As a result, the pending claims define an invention different than the invention of the '406 patent.

11. The grounds of rejection have been reconsidered in light of applicant's arguments, but are still deemed to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).